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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

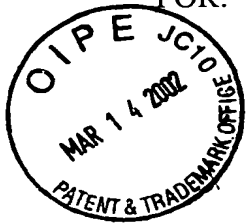
IN RE APPLICATION OF: :

DAVID ROCHON ET AL : : EXAMINER: JANVIER

SERIAL NO: 09/418,509 :

FILED: OCTOBER 15, 1999 : GROUP ART UNIT: 2162

FOR: SYSTEM AND METHOD FOR
DELIVERING TARGETED
PRODUCT SAMPLES AND
MEASURING CONSUMER
ACCEPTANCE VIA A COMPUTER
NETWORK



REPLY BRIEF UNDER 37 C.F.R. §1.193(b)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

The present Reply Brief amplifies several points of argument introduced in the Applicants' Appeal Brief of November 1, 2001. For convenience a clean copy of the Claims including the changes proposed by the amendment of March 14, 2002, is attached hereto.

Initially, Applicants wish to thank Examiner Janvier for withdrawing the rejections of Claims 31, 34 and 37 under 35 U.S.C. §101 and 35 U.S.C. §112, first paragraph.

For purposes of review, the remaining issues on appeal is (1) whether Applicants properly included Claim 31 in the allegation that the Group 1 Claims define over Scroggie et al (hereinafter referred to as "Scroggie") in section 3a of the Appeal Brief, and (2) whether Claims 1-37 were properly rejected under 35 U.S.C. §102(b) as anticipated by Scroggie.

Applicants respectfully assert that the inclusion of Claim 31 in to the arguments for Group 1 was proper and that the rejection as to at least Claims 6 and 16 is overcome by the

following arguments.

1. Claim 31 stands or falls with Claims 1 and 16 and should have been included in Group 1. Group 1 defines a computer network method or system that conditions transmitting a manufacturer's sample offer for a product sample to the user upon the user's profile data meeting user profile criteria associated with the manufacturer's product sample offer. Claims 31 recites a computer program comprising means for performing the steps noted above. Thus, it was proper for applicants to assert that Claim 31 is included in the list of Claims defining the limitations described in section 3a on page 6 of the Appeal Brief.

2. Appellants argued (Appeal Brief, page 7) that "the WO 97/23838 publication does not disclose or suggest a method or system for soliciting feedback regarding the product." (See page 7). In response, the Answer alleged that Scroggie teaches a method of and system comprising means for "transmitting a solicitation for feedback, by sending an e-mail or prompting user 10 to provide an evaluation of the product during registration, regarding said product from said main computer . . . over said computer network or Internet 304 to said network address or IP address for said user's computer 510."

However, the Examiner's Answer does not provide any basis for this conclusion except to say that such a teaching is (a) "anticipated by Scroggie" (Answer, page 12) or (b) "anticipated in the art" (Answer, page 7).

Applicants respectfully note that no teaching of a solicitation for feedback is present in the reference to Scroggie. Although the Office Action and the Answer allege that Scroggie teaches transmitting a solicitation for feedback by sending an e-mail or prompting user 10 to provide an evaluation of the product during product registration, the process of registration clearly does not include solicitation for feedback. *See Scroggie at page 9, line 22 through page 10, line 2.*

Scroggie teaches when the consumer has finished selecting products being offered he

or she may elect to go to the final list. Prior to generation of the final list the consumer will be required to enter a valid Internet address for e-mail and to select a supermarket in his or her area. *See Scroggie page 9, line 22 to page 10 line 2.* As noted in Applicant's Amendment filed on March 14, 2002, soliciting feedback, for purposes of the present invention, involves improving the products which are marketed to the consumer. Thus, merely prompting a consumer to provide a valid Internet address and to select a supermarket in his or her area does not qualify as soliciting feedback.

Indeed, wherever Scroggie refers to receiving information from the customer, no references comprise a solicitation for feedback. For example, Scroggie describes asking the customer to complete a marketing questionnaire 602. *Scroggie, page 22, lines 4-5.* This questionnaire requests selected personal or demographic information which the consumer may elect to volunteer. Since personal or demographic information would not provide the manufacturer with any information about specific problems with the marketed product. Scroggie also describes evaluating an incentive such as a coupon following the creation of the coupon. *Scroggie, page 17, lines 22-29,* however the process of evaluation clearly refers to a method of ensuring that the incentive or coupon contains the correct information by the provider of the incentive and not to evaluation of the product described in the incentive by the consumer as in the present application.

Therefore, since Scroggie clearly does not anticipate transmitting a solicitation for feedback regarding the product to the consumer, Claims 1, 16 and 31, which define that limitation, are allowable. Thus, the rejection of these claims is believed to be overcome.

Applicants also respectfully note that both the Office Action and the Examiner's Answer imply the method of transmitting a solicitation for feedback and the system of transmitting a solicitation of feedback are anticipated in the art. *See Office Action pages 6 and 11-12 and Examiner's Answer pages 7 and 12.*

Applicants respectfully assert that if this phrase is intention to imply the teachings of Scroggie should be combined with the teachings of the art, the proper grounds of rejection would be under 35 U.S.C. §103(a) not 35 U.S.C. §102(b). Rejections under 35 U.S.C. §102(b) are proper only if the Examiner finds a printed publication or a patent which was published or issued more than one year prior to the effective filing date of the application which disclosed the claimed invention. *MPEP 706.02(a)*.

If indeed the Examiner intended to issue a 35 U.S.C. §103(a) rejection, according to MPEP §706.02(j):

"there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure."

Clearly, these basic criteria have not been met in either the outstanding Office Action or the Examiner's Answer.

Therefore, Applicants respectfully assert that a prima facie case of obviousness under 35 U.S.C. §103(a) has not been met. Thus, Applicants respectfully request that a rejection of Claims 1, 16 and 31 on these grounds be withdrawn.

In summary, the errors made in the final rejection and the Examiner's Answer as to whether Scroggie teaches soliciting consumer feedback and establishing the required showing as to prima facie obviousness are clear. Accordingly, Appellants are entitled to a

reversal of at least these outstanding rejections and such is respectfully requested.

Respectfully submitted,

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CLAIMS:

1. (Amended) A computer network implemented method, comprising the steps of:
transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

transmitting a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and

generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer;

transmitting a solicitation for feedback regarding said product from said main computer over said computer network to said network address for said user's computer.

2. (Not Amended) The method of claim 1, further comprising the step of:
determining if said user's profile data meets said user profile criteria associated with said manufacturer's sample offer for a sample of said product.

3. (Not Amended) The method of claim 1, further comprising the step of:
determining if said main computer receives said signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

4. (Previously Once Amended) The method of claim 1, further comprising the step of:

determining if said user purchases a product for which said instructions for providing said sample of said product are generated.

5. (Not Amended) The method of claim 1, wherein said transmitting said manufacturer's sample offer comprises the step of:

storing said profile data in a consumer database.

7. (Not Amended) The method of claim 1, wherein said step of transmitting a signal comprises:

transmitting a signal prompting said user to provide said user's postal mailing address.

8. (Not Amended) The method of claim 1, further comprising the step of:

transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party.

9. (Not Amended) The method of claim 1, further comprising the step of:

mailing a coupon discounting a full price of said sample to a postal mailing address of said user.

10. (Not Amended) The method of claim 1, further comprising the step of:

mailing said sample to a postal address for said user.

11. (Not Amended) The method of claim 1, wherein said step of delivering comprises:

transmitting an electronic discount or coupon to a point of sale terminal for the full price of said sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's sample.

12. (Not Amended) The method of claim 1, wherein said step of transmitting said manufacturer's sample offer comprises the step of:

sending email over the computer network to said user.

13. (Not Amended) The method of claim 1, further comprising the step of:

storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database.

14. (Not Amended) The method of claim 13, further comprising the step of:
determining consumer conversion based at least in part on said purchase data stored in said consumer database.

15. (Not Amended) The method of claim 13, further comprising the step of:
transmitting said manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer only if said user's profile data meets said user profile criteria and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product.

16. (Amended) A computer network system, comprising:
a main computer, said main computer configured:
to transmit a signal prompting a user to provide profile data including identification of the user from over a computer network to a network address for the user's computer;
to transmit a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product;

to generate instructions for provide said sample of said product to said user in response to receipt of a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer; and

to transmit a solicitation for feedback regarding said product from said main computer over said computer network to said network address for said user's computer.

17. (Not Amended) The system of claim 16, further comprising;
means for determining if said user's profile data meets said user profile criteria

associated with said manufacturer's sample offer for a sample of said product.

18. (Not Amended) The system of claim 16, further comprising;

means for determining if said main computer receives said signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

19. (Previously Once Amended) The system of claim 16, further comprising:

means for determining if said user purchases a product for which said main computer is configured to generate instructions for providing said sample of said product.

20. (Not Amended) The system of claim 16, further comprising:

a consumer database storing said profile data.

22. (Previously Once Amended) The system of claim 16, further comprising;

means for transmitting a signal prompting said user to provide said user's postal mailing address.

23. (Not Amended) The system of claim 16, further comprising:

means for transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party.

24. (Not Amended) The system of claim 16, further comprising:

means for mailing a coupon for a free one of said samples to a postal mailing address of said user.

25. (Not Amended) The system of claim 16, further comprising:

means for mailing said sample to a postal address for said user.

26. (Not Amended) The system of claim 16, further comprising:

means for transmitting an electronic discount or coupon to a point of sale terminal for the full price of a sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's sample.

27. (Not Amended) The system of claim 16, further comprising:

means for sending email over the computer network to said user.

28. (Not Amended) The system of claim 16, further comprising:

means for storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database.

29. (Previously Once Amended) The system of claim 28, further comprising:

means for determining consumer conversion based at least in part on said purchase data stored in said consumer database.

30. (Previously Once Amended) The system of claim 28, further comprising:

means for transmitting said manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer only if said user's profile data meets said user profile criteria and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product.

31. (Amended) A computer program product storing computer instructions for performing a network implemented method, said program comprising means for performing the steps of:

transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

transmitting a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and

generating instructions for providing said sample of said product to said user if said

main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer; and

transmitting a solicitation for feedback regarding said product from said main computer over said computer network to said network address for said user's computer.

32. (Not Amended) The method of claim 1, wherein said step of transmitting a manufacturer's sample offer for a sample of a product comprises transmitting a manufacturer's sample offer for a sample of a packaged good product.

33. (Not Amended) The system of claim 16, wherein said main computer is configured to transmit a manufacturer's sample offer for a sample of a packaged good product.

34. (Not Amended) The product of claim 31, wherein said means for performing said step of transmitting a manufacturer's sample offer for a sample of a product comprises means for transmitting a manufacturer's sample offer for a sample of a packaged good product.

35. (Not Amended) The method of claim 1, wherein the step of generating instructions for providing said sample of said product to said user comprises generating instructions for packing and shipping the sample of the product to said user.

36. (Not Amended) The system of claim 16, wherein said main computer is configured to generate instructions for packing and shipping the sample of the product to said user.

37. (Not Amended) The product of claim 31, wherein said means for performing said step of generating instructions for providing said sample of said product to said user comprises means for generating instructions for packing and shipping the sample of the product to said user.